

### **REMARKS**

Claims 1-4, 15, 31 and 32 are rejected under 35 U.S.C. §103(a) as being unpatentable over *Helstab, et al.* (U.S. 6,073,031) in view of *Nojima, et al.* (U.S. 6,336,038). Claims 5 and 6 are rejected under 35 U.S.C. §103(a) as being unpatentable over *Helstab et al.* and *Nojima, et al.* as applied to claim 4 above, and further in view of *Uchiyama* (U.S. 2002/0072390). Claims 7, 8, 10, 11 and 16 are rejected under 35 U.S.C. §103(a) as being unpatentable over *Helstab et al.* as applied to claims 4 and 15 above, and further in view of *Obata et al.* (U.S. 5,960,208). Claim 9 is rejected under 35 U.S.C. §103(a) as being unpatentable over *Helstab et al.* and *Nojima et al.* and *Obata et al.* as applied to claim 7 above, and further in view of *Uchiyama*. Claims 12 and 13 are rejected under 35 U.S.C. §103(a) as being unpatentable over *Helstab et al.* and *Nojima et al.* as applied to claim 2 above, and further in view of *Freadman* (U.S. 6,546,262). Claim 14 is rejected under 35 U.S.C. §103(a) as being unpatentable over *Helstab et al.* and *Nojima et al.* and *Freadman* as applied to claim 13 above, and further in view of *Obata et al.* Claim 17 is rejected under 35 U.S.C. §103(a) as being unpatentable over *Helstab, et al.* and *Nojima et al.* and *Obata et al.* as applied to claim 16 above, and further in view of *Freadman*. Claims 18-21 are rejected under 35 U.S.C. §103(a) as being unpatentable over *Helstab, et al.* in view of *Nojima et al.* and *Obata et al.* Claim 22 is rejected under 35 U.S.C. §103(a) as being unpatentable over *Helstab et al.* in view of *Nojima et al.* and *Freadman*. Claim 23 is rejected under 35 U.S.C. §103(a) as being unpatentable over *Helstab, et al.* and *Nojima et al.* and *Freadman* as applied to Claim 22 above, and further in view of *Obata et al.* Claims 24, 25 and 28-30 are rejected under 35 U.S.C. §103(a) as being unpatentable over *Helstab, et al.* and *Nojima et al.* and *Freadman* and further in view of *Obata et al.* Claims 26 and 27 are rejected under 35 U.S.C. §103(a) as being unpatentable over *Helstab, et al.* and *Nojima et al.* and *Freadman* and further in view of *Obata et al.* as applied to Claim 25 above *Kobayashi*.

Applicants traverse these rejections on the grounds that these references are defective in establishing a *prima facie* case of obviousness.

Independent claims 1, 2, 18, 22 and 24 each include: an energy source internal to the docking station which supplies energy to the docking station and to a rechargeable energy source in the wireless communications device when the wireless communications device is received in the cradle and which supplies energy to the wireless device when the docking station is mobile.

As the PTO recognizes in MPEP §2142:

...The Examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the Examiner does not produce a *prima facie* case, Applicant is under no obligation to submit evidence of nonobviousness.

Applicants submit that the Examiner cannot factually support a *prima facie* case of obviousness for the following reasons.

The references do not teach or suggest an energy source internal to the docking station which supplies energy to the docking station and to a rechargeable energy source in the wireless communications device when the wireless communications device is received in the cradle and which supplies energy to the wireless device when the docking station is mobile.

35 U.S.C. § 103 states:

*A patent may not be obtained... if the difference between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains... (emphasis added).*

Thus, when evaluating a claim for determining obviousness, all limitations of the claim must be evaluated. Therefore, to sustain this rejection, the combinations suggested by the Examiner must contain all of the elements of the respective claims.

A relevant portion of the MPEP § 2142 states:

...The Examiner must step backward in time and into the shoes worn by the hypothetical 'person of ordinary skill in the art' when the invention was unknown and just before it was made....The Examiner must put aside knowledge of the Applicant's disclosure, refrain from using hindsight, and consider the subject matter claimed 'as a whole.'

Here, the references cited by the Examiner fail to teach or even suggest the desirability of the combinations set forth in independent claims 1, 2, 18, 22 and 24.

Thus, it is clear that none of the references provide any incentive or motivation supporting the desirability of the combination. Accordingly, there is no basis in the art for combining the references to support 35 U.S.C. § 103 rejections of the independent claims and their dependent claims.

Also, the MPEP §2143.01 provides:

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).

In the above context, the courts have repeatedly held that obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination.

In the present case, the combinations suggested by the Examiner result solely from hindsight based on the invention without any showing, suggestion, incentive, or motivation in any of the references from the suggested combinations as applied to independent claims 1, 2, 18, 22, and 24.

In view of the above, Applicants respectfully submit that remaining claims 1-5, 7, 8, 17-20 and 22-27 are in condition for allowance. Accordingly, an early Notice of Allowance is courteously solicited.

Respectfully submitted,



James R. Bell  
Registration No. 26,528

Dated: 9-2-04  
HAYNES AND BOONE, L.L.P.  
901 Main Street, Suite 3100  
Dallas, Texas 75202-3789  
Telephone: 512/867-8407  
Facsimile: 214/200-0853  
ipdocketing@haynesboone.com

A-166621\_1.DOC

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.	
on	<u>9/2/04</u>
Date	<u>MM</u>
Signature	<u>NISHI PASARYA</u>
Typed or Printed name of person signing Certificate	